

**REMARKS**

Applicants respectfully request reconsideration in view of the amendment and following remarks. Claims 31-37 are rejected under 35 U.S.C. § 102(b) as being anticipated by Cardarelli et al. U.S. Patent No. 3,590,119 ("Cardarelli '119"). Claims 20-22, 27 and 31-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardarelli et al. U.S. Patent No. 4,400,374 ("Cardarelli '374"), in view of Cardarelli '119. Claims 19 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardarelli '374 in view of Cardarelli '119 and Kanda et al. U.S. Patent No. 4,923,894 ("Kanda"). Claims 23-25, 28 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardarelli '374 in view of Cardarelli '119 and Jacobs et al. WO 98/271125 (equivalent to Jacobs U.S. Patent No. 6,365,686 ("Jacobs '686")). Claims 30 and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardarelli '374 in view of Cardarelli '119 and Eby, III U.S. Patent No. 5,409,905 ("Eby '905"). The applicants respectfully traverse these rejections.

**35 U.S.C. § 102 REJECTION**

Claims 31-37 are rejected under 35 U.S.C. § 102(b) as being anticipated by Cardarelli '119. The present invention relates to a microparticle for controlled active substance release comprising at least one cycloolefin copolymer, wherein the cycloolefin copolymer is a norbonene-ethylene copolymer and/or tetracyclododecene-ethylene copolymer (see Claim 36).

Cardarelli '119 discloses a larvicidal ethylenepropylene-diene terpolymer ("EPDM") rubber composition. However Cardarelli '119 does not disclose the specific cycloolefin copolymer (COC) of **the microparticle of the present invention** for the following reasons:

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a) the EPDM rubber of Cardarelli '119 is a terpolymer of Ethylene-Propylene-Diene while the COC of the present invention is a bipolymer;

b) the EPDM of Cardarelli '119 rubber comprises as an essential comonomer a higher alpha-olefin such as propylene, such comonomer is not contained in the COC of the present invention (see col. 6, lines 16-17 which state 25% and 79.5% monomer units by weight of higher alpha-olefin); and

c) the non-conjugated diolefin of Cardarelli '119 is specified as that it can be ethylene norbornene (col. 5, lines 56-68) which is different from the comonomers norbornene or tetracyclododecene of the COC of the present invention.

Accordingly Cardarelli '119 does not disclose the COC of the microparticle of the present invention. Therefore, claim 36 is clearly novel over Cardarelli '119.

#### **REJECTION OF CLAIMS 20-22, 27 and 31-37**

Claims 20-22, 27 and 31-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardarelli '374, in view of Cardarelli '119. The Examiner acknowledges at page 4, line 1 of her Office Action that Cardarelli '374 does not teach the COC of the present invention. As set forth above, Cardarelli '119 does not teach the COC of the present invention. Accordingly the combination of the teachings of Cardarelli '374 and Cardarelli '119 does not lead one of ordinary skill in the art to the present invention and therefore the applicants' claimed invention is not obvious over this combination. For the above reasons, this rejection should be withdrawn.

**REJECTION OF CLAIMS 19 and 26**

Claims 19 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardarelli '374 in view of Cardarelli '119 and Kanda. Claims 19 and 26 depend on Claim 36. As stated above for claim 36, independent claim 36 is not obvious from the cited references (see the arguments above for Cardarelli '374, in view of Cardarelli '119). The dependent claims 19 and 26 are also not obvious since these claims further limit claim 36. Kanda also does not teach the COC of the present invention. Accordingly, the combination of the teachings of Cardarelli '374, Cardarelli '119 and Kanda does not lead to the present invention (not teach the applicants' claimed COC). Therefore, this rejection should be withdrawn.

**REJECTION OF CLAIMS 23-25, 28 and 29**

Claims 23-25, 28 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardarelli '374 in view of Cardarelli '119 and Jacobs '686. It is recognized that Jacobs '686 discloses that the COC can be ethylene norbornene copolymers and ethylene-tetracyclodocene copolymers (col. 24, lines 1-5). However, Jacobs does not disclose an active substance which has been embedded in a matrix (as is required by independent claim 36).

35 U.S.C. §103 requires that the claimed subject matter as a whole not be obvious to a person of ordinary skill in the art at the time the invention was made. This phrase guards against entering into the tempting, but forbidden zone of hindsight. Applicants respectfully submits that the Examiner is resorting to prohibited hindsight in the rejection of the claims while utilizing the present disclosure as a blueprint for the formulated rejection. The Examiner may properly reject the claims in this application by showing a suggestion, teaching or motivation to combine the

prior art. However, no such suggestion, teaching or motivation exists in the prior art combination of Cardarelli '374 in view of Cardarelli '119 and Jacobs '686 relied upon in the rejection.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters **without any direction** as to the particular one selection of the reference **without proper motivation**. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** is suggested by the prior art (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicants' combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469,473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this

combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). Applicants respectfully submit that there is no reason for one skilled in the art to combine Cardarelli '374 in view of Cardarelli '119 and Jacobs '686 and such rejection should be withdrawn.

### **REJECTION OF CLAIMS 30 AND 38**

Claims 30 and 38 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Cardarelli '374 in view of Cardarelli '119 and Eby '905. Claims 30 and 38 depend on claim 36. Claim 36 is not obvious from Cardarelli '374 in view of Cardarelli '119 for the reasons stated above (the prior art does not teach the applicants' claimed COC). Eby '905 does not cure the deficiencies of Cardarelli '374 and Cardarelli '119 (teaching the COC of the present invention). Accordingly also the combination of the teachings of Cardarelli '374, Cardarelli '119 and Eby '905 does not lead one of ordinary skill in the art to the present invention. For the above reasons, this rejection should be withdrawn.

Application No.: 09/744,621

Docket No.: 09879-00017-US

No additional fee is due. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 09879-00017-US from which the undersigned is authorized to draw.

Respectfully submitted,

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